

Remarks

Amendments to the Specification

The text of the specification has been amended as provided above in order to correct a minor typographical error. In particular, the text of the specification at page 4, line 12 as originally filed has been amended so that the text "peripheral 140" now reads as "peripheral server 140". No new matter has been added by this amendment.

Amendments to the Abstract

The text of the Abstract has been replaced with a new Abstract as provided above, pursuant to the word count limitation prescribed by 37 C.F.R. §1.72(b). No new matter has been introduced through the replacement of the Abstract text.

Amendments to the Claims

Claims 1-13 have been cancelled. Claims 14-16 have been amended. New claims 21-32 have been added. Support for these amendments is found in the specification at least at page 2, line 10 to page 5, line 29 as originally filed. No new matter has been added through this amendment.

Objection to Specification

The specification is objected to because due to the following informalities and grammatical errors: at page 4, lines 11 and 12, "peripheral 140" is not represented in the figures (page 2 of Office Action). Amendment to correct this typographical error has been provided above. The Applicants believe the objection to the specification is now moot in view of the correction provided herewith.

(Continued on next page.)

1 Rejection of Claims under 35 U.S.C. § 112

2 Claims 5 and 7 (now cancelled) are rejected under 35 U.S.C. 112, second
3 paragraph, as being indefinite for failing to particularly point out and distinctly claim
4 the subject matter that the Applicant regards as the invention. In regard to claim 5,
5 the Examiner has asserted that the term "PML" is unclear. With respect to claim 7,
6 the Examiner has asserted that the term "UI_SELECT_OPTION" is of uncertain
7 meaning (pages 2-3 of Office Action).

8 While these specific rejections are now moot by virtue of the cancellation of
9 claims 5 and 7 as submitted herewith, the Applicant believes that future rejections
10 and/or uncertainty in regard to these respective terms can be avoided in view of the
11 following:

12 With respect to the term "PML", the Examiner is respectfully referred to page
13 5, lines 4-8 of the specification as originally filed. Therein, it is stated that: "PML is a
14 protocol for communicating with directly connected (e.g., parallel or USB port)
15 devices. PML is similar to SNMP (simple network management protocol), which is
16 used for network connected devices instead." Thus, the Applicants assert that the
17 term "PML" is adequately defined such that one of ordinary skill in the computer
18 related arts can understand and use the present invention.

19 In turn, the term "UI_SELECT_OPTION", is described (i.e., defined) as being
20 a PML object at page 5, line 5 of the specification as originally filed. This same
21 description is further provided at page 2, lines 15-16 of the specification as originally
22 filed. As one of ordinary skill in the computer related arts is aware of objects as used
23 within the context of a communications protocol, the Applicants believe that the term
24 "UI_SELECT_OPTION" is adequately defined such that one of ordinary skill in the
25 computer related arts can understand and use the present invention.

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S/N: 09/771,158
Case 10002193-1
Amendment "A"

1 Rejection of Claims under 35 U.S.C. § 102

2 Claims 1-4, 6, 9, 11, 14-16 and 18 have been rejected under 35 U.S.C. § 102
3 as being anticipated by U.S. Patent No. 6,219,151 ("Manglapus").

4 As claims 1-13 have been cancelled herewith, the respective § 102 rejections
5 of claims 1-4, 6, 9 and 11 are now believed moot.

6 The Applicants respectfully disagree that claims 14-16 and 18 are anticipated
7 by Manglapus.

8 As a starting point, the PTO and the Federal Circuit provide that §102
9 anticipation requires each and every element of the claimed invention to be
10 disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d
11 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited
12 §102 reference of any claimed element negates the anticipation. (*Kloster*
13 *Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.
14 1986)). Furthermore, "[a]nticipation requires that all of the elements and limitations
15 of the claims are found within a single prior art reference." (*Scripps Clinic and*
16 *Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010
17 (Fed. Cir. 1991) (emphasis added)). Moreover, the PTO and the Federal Circuit
18 provide that §102 anticipation requires that there must be no difference between the
19 claimed invention and the reference disclosure. (*Scripps Clinic and Research Found.*
20 *v. Genetech, Inc.*, *id.* (emphasis added)).

21 Accordingly, if the Applicants can demonstrate that any one element or
22 limitation in claims 14-16, as amended, and 18 is not disclosed by Manglapus, then
23 the respective claim(s) must be allowed.

24 In the following arguments, the Applicants will focus in particular on
25 independent claims 14 and 16, as amended, as the Applicants believe those claims
to be allowable over Manglapus. It is axiomatic that any dependent claim which
depends from an allowable base claim is also allowable, and therefore the

1 Applicants do not believe it is necessary to present arguments in favor of each and
2 every dependent claim.

3

4 Claim 14

5 The Applicants contend that claim 14, as amended (and rejected claim 15, as
6 amended, which depends therefrom) are not anticipated by Manglapus. With
7 respect to claim 14, as amended, that claim includes the following features and
8 limitations:

9

10 A method for a client to discover a peripheral address, by way of
11 a peripheral server, the method comprising:

12 sending a first message to the peripheral server, wherein the
13 first message contains an address of the client; and

14 receiving at the client a second message containing the
15 peripheral address, wherein the first message is formatted as a print
16 job, the print job including no content resulting in a printed output.

17 (Emphasis added.)

18

19 Manglapus fails to provide sending a first message to the peripheral server,
20 wherein the first message contains an address of the client, wherein the first
21 message is formatted as a print job, the print job including no content resulting
22 in a printed output, as recited in combination with the other features of claim 14, as
23 amended.

24 Rather, Manglapus is directed to send a print job to a printer, wherein the
25 print job does include printable content (for purposes of generating hardcopy), and
where in turn the receiving printer uses the address of the client (provided within the
print job) so as to report status information, error messages, etc., corresponding to

1 that print job back to the client (Abstract; page 10, lines 15-29 of Manglapus). In any
2 case, Manglapus does not provide, teach or suggest a message formatted as a print
3 job, the print job including no content resulting in a printed output, as recited, in
4 varying language, in combination with the other features of instant claim 14, as
5 amended.

6 Thus, Manglapus fails to provide at least one feature or limitation as recited
7 by claim 14, as amended. Accordingly, the rejection of claim 14, as amended, is
8 unsupportable in view of the inadequacies of Manglapus. Therefore, claim 14, as
9 amended, is allowable. As claim 15, as amended, depends from claim 14, as
10 amended, it is axiomatic that claim 15 is allowable by virtue of its dependence from
11 an allowable base claim.

12

13 Claim 16

14 The Applicants contend that claim 16, as amended (and rejected claim 18,
15 which depends therefrom) are not anticipated by Manglapus. With respect to claim
16, as amended, that claim includes the following features and limitations:

17

18 An apparatus comprising:
19 a client computer;
20 a peripheral server, ...; and
21 a peripheral, ..., wherein:

22 the first message is formatted as a print job, the print job
23 including no content resulting in a printed output;
24 the peripheral includes at least one non-printer function;
25 and

the client computer is configured to access the at least one non-printer function of the peripheral using the peripheral's address and without using the peripheral server.

(Emphasis added.)

As stated above, Manglapus fails to provide a first message formatted as a print job, the print job including no content resulting in a printed output, as recited in combination with the other features of instant claim 16, as amended. Furthermore, Manglapus fails to provide a peripheral including at least one non-printer function, wherein a client computer is configured to access the at least one non-printer function of the peripheral using the peripheral's address and without using the peripheral server, as recited, in varying language, in combination with the other features of claim 16, as amended.

In contrast, Manglapus is completely devoid of a peripheral including at least one non-printer function. Again, Manglapus is directed to providing the address of a client computer to a printer, by way of a print job, such that the printer may report status information regarding that print job back to the client computer. Manglapus does not provide, teach or suggest accessing any kind of non-printer function within a peripheral, once the address for that peripheral has been communicated to the client computer.

Thus, Manglapus fails to provide at least two features as recited by claim 16, as amended. Therefore, claim 16, as amended, is allowable. As claim 18 depends from claim 16, as amended, it too is allowable at least by virtue of its dependence from an allowable base claim.

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1 Rejection of Claims under 35 U.S.C. § 103

2 Claims 10 and 17 have been rejected under 35 U.S.C. § 103(a) as being
3 unpatentable over U.S. Patent No. 6,219,151 ("Manglapus").

4 Claims 5-7 have been rejected under 35 U.S.C. § 103(a) as being
5 unpatentable over Manglapus, in view of U.S. Patent No. 6,094,548 ("Gunning").

6 Claim 8 has been rejected under 35 U.S.C. § 103(a) as being unpatentable
7 over Manglapus, in view of U.S. Patent No. 5,687,320 ("Wiley").

8 Claims 12-13 and 19-20 have been rejected under 35 U.S.C. § 103(a) as
9 being unpatentable over Manglapus, in view of U.S. Patent No. 6,728,012
10 ("Bacher").

11 As described above, claims 1-13 have been cancelled. Thus, the respective
12 103 rejections of claim 5-7, 8, 10, and 12-13 are believed moot.

13 The Applicants respectfully disagree that claims 17 and 19-20 are obvious as
14 respectively rejected above.

15 As a starting point, MPEP 706.02(j) states:

16
17 "[t]o establish a *prima facie* case of obviousness, three basic
18 criteria must be met.

19 First, there must be some suggestion or motivation, either in the
20 cited references themselves or in the knowledge generally available to
21 one of ordinary skill in the art, to modify the reference or to combine
22 the reference teachings.

23 Second, there must be a reasonable expectation of success.

24 Finally, the prior art reference (or references when combined)
25 must teach or suggest all the claim limitations. The teaching or
 suggestion to make the claimed combination and the reasonable

1 expectation of success must both be found in the prior art and not
2 based on applicant's disclosure."

3 (Emphasis added.)

4

5 With respect to claims 17 and 19-20, those claims depends from claim 16, as
6 amended. For at least the reasons stated above, the Applicants contend that claim
7 16, as amended, is allowable. It is axiomatic that claims 17 and 19-12 are also
8 allowable by virtue of their dependence from an allowable base claim.

9 In regard to claim 17, that claim includes all of the limitations of claim 16, as
10 amended, from which it depends. Claim 17 includes one or more limitations, in a
11 particular combination, that is neither taught nor suggested by Manglapus.
12 Therefore, claim 17 is allowable.

13 In regard to claim 19, that claim includes all of the limitations of claim 16, as
14 amended, from which it depends. Furthermore, claim 19 recites the peripheral is a
15 multi-function peripheral, in combination with the other limitations of claim 16 from
16 which it depends. Neither Manglapus nor Bacher – alone, or in any combination –
17 teaches or suggests all of the limitations, nor the particular combination, of claim 19.
18 Therefore, claim 19 is allowable.

19 In regard to claim 20, that claim includes all of the limitations of claim 16, as
20 amended, from which it depends. Claim 20 includes one or more limitations, in a
21 particular combination, that is neither taught nor suggested by Manglapus or Bacher,
22 alone or in any combination. Therefore, claim 20 is allowable.

23

24 Summary

25 The Applicants believe that this response constitutes a full and complete
response to the Office Action. The Applicants respectfully request reconsideration

1 of claims 14-20, as respectively amended, as well as consideration on the merits of
2 new claims 21-32, in favor of timely allowance.

3 The Examiner is respectfully requested to contact the below-signed
4 representative if the Examiner believes this will facilitate prosecution toward
5 allowance of the claims.

6
7 Respectfully submitted,

8 Larry A. COPP
9 Matt HOWELL

10 Date: July 2, 2004

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Case 10002193-1
Amendment "A"